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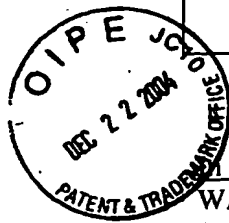
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It is certified that a copy of this Response to Protest under 37 CFR § 1.291(a) has been served in its entirety on the Protester's attorney of record pursuant to 37 CFR § 1.248 by first class mail on December 22, 2004. The name and address of the attorney of record served is: David L. Fehrman, Morrison & Foerster LLP, 555 West Fifth Street, Suite 3500, Los Angeles, California 90013.

Dated: December 22, 2004

Signature:

Richard J. Ward, Jr.



## IN THE UNITED STATES PATENT AND TRADEMARK

*In re* Reissue Patent Application of:

WASHINO ET AL.

Serial No. 10/004,046

Group No.

2614

Filing Date: October 24, 2001

Examiner:

David E. Harvey

Title: MULTI-FORMAT AUDIO/VIDEO  
PRODUCTION SYSTEM

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

ATTENTION: Technology Center 2600

### RESPONSE TO PROTEST UNDER 37 CFR § 1.291(a)

This is a response to a Protest filed July 12, 2004 objecting to all claims then pending in the above identified application (claims 26-33 and 36-255). A communication inviting response by the Applicant was mailed by the EXAMINER on November 24, 2004.

#### I. INTRODUCTION

Reissue is a procedure, provided for by statute, enabling patentees to correct errors in patents which render the patent wholly or partly inoperative. Such error includes failing to claim all that the patentee was entitled to claim. In such event, the patent claims may be broadened during reissue, when the reissue is applied for within two years of the issuance of the original patent (as is the case here). "Whenever any patent is, through error without any deceptive intention, deemed wholly or partially inoperative ... by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall . . . reissue the patent for the invention disclosed in the original patent ...." 35 U.S.C. §251. The statute is remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally. *In re Weiler*, 790 F.2d 1576, 1579 (Fed. Cir. 1986). Broadened claims in a reissue application are allowed when support is found within the entire disclosure.

**A. Procedural Posture**

The current application was filed October 4, 2001, as a continuation of App. Ser. No. 09/113,615 (filed July 10, 1998), which issued as RE 38,079, based on previously issued U.S. Pat. No. 5,537,157 (the " '157 patent"). It is assigned to Multi-Format, Inc. ("Multi-Format"). The current reissue was filed based on error in the original '157 patent, as set forth in the declarations of Schwab and Washino in the reissue application. In short, that error may be summarized as a failure of the applicant to claim all to which he was entitled. Such was already found to be the case in RE 38,079, and the current application is based on additional errors within the '157 patent which was not corrected by the claims of RE 38,079. Thus, as in any reissue proceeding, the focus must be on the original patent, in this case the '157 patent, including the specification, claims and prosecution history, and the claims pending in the current application.

A protest was filed collectively by a group of approximately twenty-four entities, referred to hereinafter as the Protestors. In large part, the protest is based on two arguments: the doctrines of restriction acquiescence and recapture estoppel. In addition, the Protestors devote several pages of the protest to their interpretations of Multi-Format's actions in litigation based on RE 38,079, and the dollar amounts that Protestors believe are at stake. While these issues are clearly of interest to the Protestors, they provide no relevant information regarding the patentability of the currently pending claims of the present reissue application, and appear intended simply to distract the focus of the Examiner from the real issues, which are the current claims of this application, and their relation back to U.S. Pat. No. 5,537,157, of which the current application is a reissue.

A non-final office action was mailed on November 26, 2003. A response to the office action was timely filed May 26, 2004. The protest was served on July 12, 2004. An Information Disclosure Statement disclosing additional prior art was filed August 27, 2004. On November

24, 2004, a communication inviting the applicant to respond to the protest was mailed. An amendment was filed December 3, 2004, canceling claims 26-255 and adding new claims 256-293.<sup>1</sup>

**B. The December 3, 2004 Amendment Renders The Arguments Made in the Protest Moot.**

As noted above, by amendment dated December 3, 2004, the landscape of the pending claims was changed. Previously pending claims 26-255, to which the arguments of the protest were directed, were canceled, and new claims 256-293 were added. The language of the new claims differs from that of the previously pending claims, and none of the arguments of the protest are directed to the new claims, rendering the protest moot. To the extent that the Protestors may claim that the arguments of the protest are still applicable, the issues are addressed below.<sup>2</sup>

**II. THE DOCTRINE OF RESTRICTION ACQUIESCENCE IS INAPPLICABLE TO NEW CLAIMS 256-293**

The Protestors contend that the doctrine of "restriction acquiescence" precludes Multi-Format from pursuing any of claims 26-254. While those claims are no longer pending, and therefore Protestors' argument with respect to such claims is moot, as shown below, the doctrine is similarly inapplicable to new claims 256-293.

**A. Law Regarding Restriction Acquiescence**

Restriction acquiescence is a doctrine that applies only to limited situations during certain reissue proceedings. "[R]eissue claims must be for the invention as that disclosed as being the

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<sup>1</sup> On December 3, 2004, applicants also filed two additional continuation reissue patent applications which are also based on errors in the prosecution of the '157 patent.

<sup>2</sup> As the Protest to which this Response relates is not directed to the current reissue claims, applicants reserve the right to address, at the appropriate time and in the appropriate forum, any contentions with respect to the current reissue claims (or any other claims) with amended or new responses at a later date.

invention in the original patent, as required by 35 U.S.C. 251." *M.P.E.P. § 1412.01*. "The entire disclosure, not just the claim(s), is considered in determining what the patentee objectively intended as his or her invention." *Id.* Here, the original patent is U.S. Pat. No. 5,537,157.

Merely finding that the subject matter was "not originally claimed, not an object of the original patent, and not depicted in the drawing," does not answer the essential inquiry under the "original patent" clause of § 251, which is whether one skilled in the art, reading the specification, would identify the subject matter of the new claims, as invented and disclosed by the patentees.

*In re Amos*, 953 F.2d 613, 618-619 (Fed. Cir. 1991).

The doctrine of restriction acquiescence, sometimes referred to as the *Orita* doctrine, may be applicable when the patentee faced a restriction requirement in the prosecution of the original patent (the patent now being reissued – in this case, the '157 patent). When a patentee encounters a restriction requirement, and elects to pursue certain claims, but does not pursue a divisional application for the nonelected claims, restriction acquiescence precludes the patentee from later obtaining in reissue proceedings claims that are substantially identical to the nonelected claims which the patentee chose not to pursue. "The so-called *Orita* doctrine therefore precludes a reissue applicant from obtaining substantially identical claims to those of nonelected groups identified in an Examiner's restriction requirement when such claims could not have been prosecuted in the application from which they were restricted." *In re Doyle*, 293 F.3d 1355, 1359 (Fed. Cir. 2002).

The Federal Circuit in *Doyle* held that the doctrine of restriction acquiescence does not apply to claims in a reissue if those claims could have been prosecuted in the application from which they were restricted. *See, In re Doyle*, 293 F.3d at 1360 ("There is another critical, and indeed dispositive difference between the present case and *In re Orita*: Dr. Doyle could have prosecuted his reissue claims with the claims of the elected group.")

In *Doyle*, the reissue claims read on the non-elected claims, but were not substantially similar to the non-elected claims; i.e., the reissue claims were broader than the non-elected claims and were genus claims which could link the non-elected claims to the elected claims. In other words, the reissue claims could have been prosecuted with the elected claims. *In re Doyle*, 293 F.3d at 1360 ("Dr. Doyle could have prosecuted his claims with the elected group without running afoul of the restriction requirement because they are linking claims. See *Manual of Patent Examining Procedure* § 809.03 (8th ed. 2001) ("MPEP"). Furthermore, the new claims are broader than the issued claims, and therefore the issued claims are "wholly or partly inoperative or invalid...by reason of the patentee claiming...less than he had a right to claim in the patent." 35 U.S.C. § 251 (1994). In other words, Dr. Doyle has successfully asserted an error in the issued patent correctable by reissue and *In re Orita* does not--and cannot--limit his statutory right to seek reissue under the circumstances.")

The court refused to follow *Orita* and held that the doctrine of restriction acquiescence was limited to claims that not only read on non-elected subject matter, but also are substantially identical to the non-elected claim(s):

*In re Orita* did not create a broad rule disallowing any reissue claims that read on nonelected subject matter. As discussed above, the reissue claims asserted in *In re Orita* did not just read on nonelected subject matter, but rather were "substantially identical to those non-elected in [the] application." *In re Orita*, 550 F.2d at 1280, 193 U.S.P.Q. (BNA) at 149. As discussed above, the rationale underlying *In re Orita* and the holding of that case extend only to claims that are identical to or of substantially similar scope to those of the nonelected group.

*In re Doyle*, 293 F.3d at 1361.

Thus, the Federal Circuit held in *Doyle* that the doctrine of restriction acquiescence does not apply where the reissue claims: (1) are not substantially identical to the nonelected claims,

(2) could have been prosecuted with the elected claims (for example, the claims are broad enough to read on both the elected and non-elected claims (so-called 'linking claims')), and (3) are broader than the issued claims (meaning that the applicants claimed less than they had a right to claim and thus the applicants will have successfully asserted an error in the issued patent correctable by reissue):

"[Patentee's] new claims are neither identical nor substantially similar to the nonelected claims. [Patentee's] new claims are genus claims, whereas the nonelected claims are species that fall within the new genus claims. In other words, the reissue claims are substantially broader than the claims of the nonelected groups. Thus the estoppel rationale underlying *In re Orita* and *In re Watkinson* does not apply here.... The case is different where, as here, the applicant never asserted the reissue claims or anything similar to them in his original application, and never agreed to prosecute the reissue claims in a divisional application. . . . There is another critical, and indeed dispositive difference between the present case and *In re Orita*: Dr. Doyle could have prosecuted his reissue claims with the claims of the elected group. . . . Furthermore, the new claims are broader than the issued claims, and therefore the issued claims are 'wholly or partly inoperative or invalid . . . by reason of the patentee claiming . . . less than he had a right to claim in the patent.' 35 U.S.C. § 251 (1994). In other words, Dr. Doyle has asserted an error in the issued patent correctable by reissue and *In re Orita* does not—and cannot—limit his statutory right to seek reissue under the circumstances."

*In re Doyle*, 293 F.3d at 1360.

**B. Facts of the Current Case**

In the prosecution of the parent application 08/298,104 which led to the '157 patent, the Examiner issued a restriction requirement, differentiating between the inventions of claims 1-20, and the invention of claim 21. Applicant elected the invention as set forth in claims 1-20 and canceled claim 21.

**1. Original Claims 1-20**

Claims 1-20 included three independent claims – claims 1, 13, and 17.<sup>3</sup>

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<sup>3</sup> A copy of claims 1-21, as originally filed, is attached hereto as Exhibit A.

Independent claim 1 was directed to a multi-format audio/video production system, which included a means to receive an input signal representative of an audio/video program, a graphics processor, a standard/widescreen interface unit, a high-definition television interface unit, an operator interface, and a centralized controller. Claim 2 depended from claim 1 and added the limitation that the graphics processor is operative to convert the video program in the input format into an output signal for photographic production. Claim 3 depended from claim 1 and added the limitation that the input and output signals may be compatible with certain standard formats. Claim 4 depended from claim 1 and added the limitation that the input and output signals may be compatible with a video standard utilizing separate luminance and chrominance component video signals. Claim 5 depended from claim 1 and added the limitations that the means for receiving the input video includes a digital video camera. Claim 6 depended from claim 5 and added the limitation that the digital video camera uses two charge-coupled-device image sensors. Claim 7 depended from claim 1 and added the limitation that the means to receive a video program includes a removable high-capacity magnetic storage medium. Claim 8 depended from claim 1 and added the limitation that a change in aspect ratio may occur from a conversion. Claim 9 depended from claim 1 and added the limitation that the video program in the input format includes 24 frames-per-second (fps) images and the graphics processor is operative to convert the 24 fps images into a 30 fps format. Claim 10 depends from claim 1 and adds the limitation that the video program in the input format includes 24 frames-per-second (fps) images and the graphics processor is operative to convert the 24 fps images into a 25 fps format. Claim 11 depends from claim 1 and adds the limitation that the video program in the input format includes 24 frames-per-second (fps) images and the graphics processor is operative to convert the 24 fps images into an HDTV-compatible format. Claim 12 depends from claim 1 and adds the limitation that the HDTV interface further provides means for reducing the chrominance bandwidth of an RGB signal without reducing its luminance

bandwidth.

Independent claim 13 was also directed a multi-format audio/video production system, which included a means to receive an input video program, if necessary, a means to convert the input program into a 24 frames-per-second production format, and a means to convert the production version into an output format. Claim 14 depended from claim 13 and added the limitation that the means to convert into an output format includes interpolation means to expand the number of pixels associated with the production format. Claim 15 depended from claim 13 and added the limitation that the means to convert the production format into an output format includes image sequencing means to convert the 24 fps production format into a 30 fps output format. Claim 16 depended from claim 13 and added the limitation that the means to convert the production format into an output format includes means to increase the 24 fps production format into a 25 fps output format.

Independent claim 17 was directed to a method of producing a video program, which included the steps of receiving an input program, converting the input program into a production format, displaying the video program, manipulating the video program to create a desired edited version of the program, and outputting the program in a final format. Claim 18 depended from claim 17 and added the limitation that the step of manipulating the video program to create a desired edited version of the program in the final format includes using an image-sequencing technique to convert the 24 fps production format into an edited version of the program in a final format of 30 fps. Claim 19 depended from claim 17 and added the limitation that the manipulating step included the step of interpolating to produce an edited version of the program having pixel dimensions greater than that of the production format. Claim 20 depended from claim 17 and added the limitation that the step of manipulating the video program to create a desired edited version of the program in the final format includes using an image-sequencing technique to convert the production format into an output format includes the step of increasing



the frame rate to increase the frame rate to produce an edited version of the program in a final format of 30 fps.

**2. Original Claim 21**

Claim 21 was directed to a method of reducing the chrominance bandwidth of the RGB signal without reducing its luminance bandwidth. Claim 21 was as follows:

21. In a video production system wherein a video program is represented in RGB form, the method of reducing the chrominance bandwidth of the RGB signal without reducing its luminance bandwidth, comprising the steps of:

- receiving the R, G, and B signals;
- low-pass filtering each of the R, G, and B signals to remove all frequency components above a specified frequency, resulting in R', G', and B' signals;
- matrixing the R, G, and B signals in a predetermined proportion;
- high-pass-filtering the matrixed signal to remove all frequency components below a specified frequency;
- symmetrically separating the high-pass filtered matrixed signal into R, G, and B components in a predetermined proportion;
- mixing each of the R', G', and B' signals with each of the R, G, and B components, respectively, to produce an output set of R, G, and B signals, each having a full luminance bandwidth but reduced chrominance bandwidth.<sup>4</sup>

**3. Current Reissue Claims 256-293**

The current reissue claims include three independent claims – claims 256, 276, and 285.

Current reissue claim 256 is directed to an audiovisual method comprising the steps of receiving audiovisual information having a frame rate of 24 fps, performing non-linear editing to

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<sup>4</sup> Although the Protestors have submitted 29 exhibits spanning well-over 500 pages, the Protestors do not submit original claims 1-21. This is important, because the Protestors' arguments regarding restriction acquiescence require that the Examiner compare reissue claims 26-255, and reissue claims 256-293 now being submitted, with original claims 1-21. Instead, the Protestors attempt to mislead the Examiner (who was not the Examiner of the '157 patent) by failing to submit the text of these claims and by mischaracterizing the subject matter of claims 1-21. For instance, the Protestors merely state that claim 21 is "drawn to a video production system for generating an image." As shown above, claim 21 is not drawn to a video production for generating an image; it is drawn to a method of reducing the chrominance bandwidth of the RGB signal without reducing its luminance bandwidth. Further, defendants characterize claims 1-20 as being "drawn to a video production system for generating an image." This characterization fails to identify any of the limitations of original claims 1-20 and thus does not provide the Examiner with the information necessary to see that reissue claims 26-255 and current reissue claims 256-293 could have been prosecuted by the applicants with the '157 patent application and that reissue claims 26-255 and current reissue claims 256-293 are broader than original claims 1-20.

create an edited version, and storing the edited version on a high capacity storage medium having a frame rate of 24 fps. Current reissue claims 257-275 are dependant claims and add limitations to current reissue claim 256, including limitations regarding outputting the edited version of the video information in a predetermined display format, and resizing the image aspect ratio of the edited version of the video information using a non-linear transformation, cropping, or panning and/or scanning.

Current reissue claim 276 is directed to a system for capturing and recording digital video information comprising a video camera for capturing digital video information at a frame rate of substantially 24 fps and a digital video recorder for recording the digital video information in a format at a frame rate of substantially 24 fps.<sup>5</sup> Current reissue claims 277-284 are dependant claims and add limitations to current reissue claim 276, including adding a graphics processor for performing at least one image manipulation, and using the graphics processor to resize the image aspect ratio of the edited version of the video information using a non-linear transformation, cropping, or panning and/or scanning.

Current reissue claim 285 is also directed to a method of capturing and storing digital video information comprising capturing digital video information at a frame rate of 24 fps and recording the digital information in a format at a frame rate of substantially 24 fps. Current reissue claims 286-293 are dependant claims and add limitations to current reissue claim 286, including adding the steps of performing at least one image manipulation on the digital video information and resizing the image aspect ratio of the edited version of the video information using a non-linear transformation, cropping, or panning and/or scanning.

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<sup>5</sup> Claim 276 contains a typographical error. The phrase "in communication with the graphics processor" should be deleted. Claims 281, 282, and 283, should be dependant on claim 277, not 276. Applicants will file a preliminary amendment to make these corrections.

C. Current Reissue Claims 256-293 Are Not Substantially Similar to Non-Elected Original Claim 21

In this case, the non-elected invention is found in original claim 21. Original claim 21 is directed to a method of reducing the chrominance bandwidth of the RGB signal without reducing its luminance bandwidth. It is indisputable that none of reissue claims 26-255 or current reissue claims 256-293 is directed to a method of reducing the chrominance bandwidth of the RGB signal without reducing its luminance bandwidth. Thus, none of reissue claims 26-255 or current reissue claims 256-293 can be substantially similar to non-elected original claim 21.

D. Current Reissue Claims 256-293 Could Have Been Prosecuted With Original Claims 1-20 of the '157 Patent

The reissue claims currently presented in the '046 application are significantly broader than the issued claims in the '157 patent. As shown in *In re Doyle*, restriction acquiescence does not apply to the instant case. Claims that seek a broadening through reissue will be allowed. Drafting reissue claims in a broader form, to address subject matter clearly and specifically disclosed in the application as filed is allowable.

Here, applicants' current reissue claims are broader claims drawn on the elected claims, not on the nonelected claims, which is precisely the type of 'error' contemplated by the reissue statute. Such claims could have been included with the original application that contained the elected claims, but by error of failing to claim all that they were entitled to, applicants omitted such claims. Put another way the claims added to the reissue are clearly part of the original invention.

This is evident from merely comparing original claims 1-20 with the current reissue claims 256-293. Claims 1-20 are directed to audio/video production systems and to audio/video production methods. In these claims, video information is received, stored (or recorded) in a format having a frame rate of 24 fps, and output in another format. Some of these claims are directed to digital cameras used to capture and record digital video information (original claims 5 and 6) and claims directed to resizing aspect ratios (original claim 8). Current reissue claims 256-293 therefore could have been included with claims 1-20 of the original application.

The Protestors cite *In re Weiler* as support for their contention that reissue claims 26-253 are separate inventions from original claims 1-20 and therefore cannot be the subject of a reissue application. *In re Weiler* is inapplicable here. As discussed in *Doyle*, *Weiler* is distinguishable from the facts in *Doyle* and in this case, because the disallowed claims were to distinct inventions not claimed at all in the original application:

There is a crucial difference between the situation in *Weiler* and the present case. [Patentee's] claims are not to an invention distinct from that of the issued claims. Rather, as the Solicitor admits, they are linking claims that read on, and could have been asserted with, the elected group. Therefore, the entire premise of *Weiler* is inapplicable to this case, for *Weiler* applies only to an attempt to assert new claims in reissue that read on a separate invention and not on the subject matter of the issued claims.<sup>6</sup>

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<sup>6</sup> In *Weiler*, it was clear that the reissue claims read on a separate invention from the original claims and had nothing to do with the subject matter of the issued claims. In *Weiler*, the original patent claims comprised three distinct inventions. The applicant elected to prosecute claims 1-7, which were directed to a method for the quantitative analysis of limonin. The non-elected claims were to an organic compound and to a protein compound. In the reissue application, the applicant sought to prosecute claims having no relation to either the elected claims or the non-elected claims of the original application. The reissue claims were directed instead to a method for developing citrus fruit strains low in limonin content and a gamma globulin fraction comprising antibodies reactive with limonin. The court found that, although there was support for these claims in the specification, the applicants could not have prosecuted these claims in the reissue application, because these claims "are independent of and distinct from each other, from that of elected claims 1-7, from that of non-elected organic compound claims 8 and 11, and from that of non-elected protein compound claims 9 and 10." *Weiler*, 790 F.2d at 1581.

*In re Doyle*, 293 F.3d at 1363.

**E. Current Reissue Claims 256-293 are Broader than the Claims of the '157 Patent**

Current reissue claims 256-293 are broader than the claims of the '157 patent. Claims 1-25 of the '157 patent include numerous limitations not found in current reissue claims 256-293, such as, for example, the high definition television interface unit and controller of claims 1-13 of the '157 patent, the general purpose computer platform, means to receive a video program, and means to convert the production format into an output format of claims 14-19 of the '157 patent, and the personal computer having a color monitor and the step of displaying the video program on the color monitor of claims 20-25.

**F. Restriction Acquiescence Does Not Apply**

As demonstrated above, applicants have established that the arguments of the protest regarding the canceled claims are moot, and as to currently pending claims 256-293, restriction acquiescence does not apply. Applicants have shown that: (1) current reissue claims 256-293 are not substantially identical to non-elected claim 21, (2) current reissue claims 256-293 could have been prosecuted with elected claims 1-20; and (3) current reissue claims 256-293 are broader than the issued claims of the '157 patent. Accordingly, applicants have set forth errors in the issued '157 patent correctable by current reissue claims 256-293, because the issued claims are "wholly or partly inoperative or invalid . . . by reason of the patentee claiming . . . less than he had a right to claim in the patent." 35 U.S.C. § 251.

**III. THE DOCTRINE OF RECAPTURE ESTOPPEL IS INAPPLICABLE TO CURRENT REISSUE CLAIMS 256-293**

Protestors also raise the doctrine of 'recapture estoppel.' Like the doctrine of 'restriction

acquiescence,' the doctrine of 'recapture estoppel' is applicable to reissue only in certain limited circumstances, based on the existence of certain events during the prosecution of the original patent. This doctrine precludes a patentee from obtaining in reissue subject matter that was surrendered during prosecution of the original patent to avoid the prior art.

A. Law Regarding Recapture Estoppel

1. Doctrine Applies Only to Amendments to Avoid Prior Art

The doctrine of recapture estoppel can be summarized as follows: "The recapture rule 'prevents a patentee from regaining through reissue the subject matter that he surrendered in an effort to obtain allowance of the original claims.'" *Pannu v. Storz Instruments, Inc.*, 258 F.3d 1366, 1370-71 (Fed. Cir. 2001) (citing *In re Clement*, 131 F.3d 1464, 1468 (Fed. Cir. 1997)). The doctrine applies where claims in reissue are identical or vary only in immaterial respects from claims that were originally abandoned during the prosecution of the original patent. See *Haliczer v. United States*, 356 F.2d 541 (Ct. Cl. 1966). However, where the reissue claims are broader than the abandoned claim in some respects, and narrower in others, such claims should be allowed:

We ... find [no authority] for the proposition that a limitation added to a claim in obtaining its allowance cannot be broadened, under present statutory law, by reissue if the limitation turns out to be more restrictive than the prior art required. Certainly one might err without deceptive intention in adding a particular limitation where a less specific limitation relative to another element, would have been sufficient to render the claims patentable over the prior art.

*In re Richman*, 409 F.2d 269, 274-275 (C.C.P.A. 1969).

In addition, the doctrine only applies when the matter was surrendered to avoid prior art. *In re Doyle*, 293 F.3d at 1358 ("[R]ecapture doctrine, which prevents an applicant from recapturing through reissue matter surrendered to overcome a rejection based on prior art, is inapplicable here because the pertinent claims were not cancelled to overcome prior art."); *Voice Capture, Inc. v. Intel Corp.*, Case No. 4:04-CV-40340, 12/2/04 Order at 13 (S. D. Iowa 2004)

(quoting *Doyle* and *AT&T Corp. v. Microsoft Corp.*, 2004 U.S. Dist. LEXIS 2192, \*22 (S.D.N.Y. 2004)). The *Pannu* court set forth the proper application of the rule:

Application of the recapture rule is a three-step process. The first step is to "determine whether and in what 'aspect' the reissue claims are broader than the patent claims." [citing *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 996 (Fed. Cir. 1993)] "The second step is to determine whether the broader aspects of the reissued claim related to surrendered subject matter." [*Id.*] Finally, the court must determine whether the reissued claims were materially narrowed in other respects to avoid the recapture rule." [citing *Hester Indus., Inc. v. Stein, Inc.*, 142 F.3d 1472, 1482-83 (Fed. Cir. 1998)].

*Pannu*, 258 F.3d at 1371.

The M.P.E.P. provides additional guidance in how to apply the recapture test:

However, if the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation), then the reissue claim may not be rejected under the recapture doctrine. *Ex Parte Eggert*, 67 USPQ2d 1716 (Bd. Pat. App. & Inter. 2003) (precedential). For example, if the key limitation added to overcome an art rejection was "an orange peel," and the reissue claim instead recites "a citrus fruit peel," the reissue claim may not be rejected on recapture grounds.

M.P.E.P. § 1412.02 (C).

**B. Facts Regarding Prosecution of '157 Patent**

**1. Amendments During Prosecution of '157 Patent**

Protestors argue that specific limitations added to the claims of the '157 patent during prosecution were added to avoid the prior art. They characterize such language as "a positive limitation regarding conversion of the display format of a video program into an intermediate production format." Protest at 16. Protestors argue that such limitation has been omitted in the reissue claims, and that the limitation that was present in some of the (now cancelled) claims regarding "converting an input format with no added redundant frames or fields into an intermediate format" was not truly a limitation. Protestors wrongly characterize this requirement

as a "product-by-process limitation." However, such limitation is not a product by process, but instead specifies a particular type of input, required for both the method and system claims. However, in light of the new claims now pending, Protestors' arguments are now moot.

A review of the file history of the '157 patent, and in particular the amendments dated August 8, 1995 and October 10, 1995, reveal that the only limitation added to avoid the prior art was the inclusion of high-capacity video storage used to store video information in a particular format. In an Office Action dated April 10, 1995 (Paper No. 4), the Examiner rejected claims 1, 2, 3, 4, 8-11 and 13-20 as being anticipated under 35 U.S.C. § 102(e) in view of Hailey, U.S. Patent No. 5,243,433 and rejected claims 5-7 as being obvious under 35 U.S.C. § 103 over Hailey in view of Sharman, U.S. Patent No. 5,045,932. In response to these rejections, the applicants amended original claim 1 to add a high-capacity storage means, to add that the graphics processor converts the display format of the program into an intermediate production format, and to add that the program is stored in the production format on the high capacity storage means. (See, Paper No. 6, at pp. 1-2).

In the remarks to the response, Applicants described the amendments to claim 1 and stated that: "Hailey neither implies nor suggests the use of such an intermediate format, nor does Hailey include any means for the storage of images...." and that "Sharman et al. does not include a high-capacity video storage means....". See Paper #6 (8/8/95 Amendment) at 10-11. In addition, in the Examiner Interview Summary Record dated May 25, 1995, the Examiner noted that "Applicant favorably argued that Hailey fails to show a 'high capacity storage means' incorporated in the proposed amended claims." See Paper #5 (Interview Summary Record dated 5/25/95). It is clear from these remarks that the amendment to claim 1 to add that the graphics processor converts the input program into a production format was made not for patentability purposes, but to provide antecedent basis for the function of the high-capacity storage means, i.e., that the high-capacity storage medium stores the video program in its production format.



Although claims 13 and 17 were also rejected over Hailey, Applicants did not amend claims 13 and 17 in response to the rejection. Claims 13 and 17 differed from claim 1. Even after the amendments to original claim 1, claim 1 did not place any limits on the frame rate of the program in its production format. Original claim 13, however, required that the production format have a frame rate of 24 frames-per-second (fps) and required that the graphics processor convert the format of the input program to a production format having a frame rate of 24 fps.<sup>7</sup> Similarly, original claim 17 required the step of converting the input program into a production format having a frame rate of 24 fps.

On October 5, 1995, the Examiner telephoned the applicants' attorney regarding claims 13 and 17. In response to that call, applicants amended claim 13 to add a high-capacity storage means limitation and to add that the production format of the program is stored on the high-capacity storage means. Applicants also amended claim 17 to add the step of storing the program in the production format on a high-capacity storage means. (See, Paper Nos. 8 and 9, dated October 10, 1995 and November 1, 1995, respectively). Thus, the only possible surrender with respect to claims 13 and 17 is the addition of the high-capacity storage means.

It is clear therefore from the prosecution history that the only possible surrender of claim coverage is the addition of the high capacity storing means for storing the program in its production format. This is especially true in claims, such as original claims 13 and 17, having the additional limitation (contained in current reissue claims 256-293) that the production format has a frame rate of 24 fps. Claims 13 and 17, which had the 24 fps limitation and which had the conversion limitations were not allowable over Hailey, but were allowable only after the applicants amended claims 13 and 17 to add the high-capacity storage means. Thus, the only

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<sup>7</sup> It is worth noting that, in original claim 13, the conversion of the input program to a production format was not required if the input program was already in the production format: "means to convert the input program into a 24 frames-per-second (fps) production format, *if necessary*, according to one of the following aspect ratios for review on the color display."

possible surrender of claim coverage in a claim which includes the limitation of the production format having a frame rate of 24 fps would be the addition of the high capacity storage means. There was therefore no surrender with respect to the converting of the input program to the production format, as Protestors contend, because this limitation was not added during prosecution of any claim to overcome the rejection to Hailey.

Each of the new pending claims 256-293 includes storage or recording, and a video format having a frame rate of 24 fps which can be stored. Of these, claims 256, 276 and 285 are independent claims. For example, method claim 256 includes an "edited version of the video information" and "storing the edited version of the video information on a high-capacity storage medium, wherein the edited version of the video information has a format embodying the compressed digital video having a frame rate of substantially 24 fps." Similarly, system claim 276 includes a high-capacity storage medium – "a digital video recorder in communication with the graphics processor for recording the digital video information" as well as a particular format for recording the information – "digital video information at a frame rate of substantially 24 fps." Finally, method claim 285 includes "recording the digital video information in a format having a frame rate of substantially 24 frames per second." Thus all of the currently pending claims have retained the limitations with regard to storage and formatting at 24 fps.

**2. Application of Three Part Recapture Test**

The recapture test, as set forth in the *Pannu* case, and at section 1412.02 of the M.P.E.P., is paraphrased below. The comparison is between the original claims of the '157 patent (before they were amended to add the above-discussed limitations regarding storage and format), sometimes referred to as the 'cancelled' claims, and the currently pending reissue claims. See M.P.E.P. § 1412.02 (C)(1).

a) **The Current Reissue Claims Are Broader Than the Claims of the '157 Patent**

As discussed in Section II.E., above, the current reissue claims are broader in some aspects than those of the '157 patent. The patentee's failure to claim all to which he was entitled is therefore the error leading to the application for reissue.

b) **The Broader Aspects of the Current Reissue Claims Do Not Relate to Surrendered Subject Matter**

The broader aspects of the pending claims relate to aspects other than surrendered subject matter – all matter that could be deemed to have been surrendered was with respect to the high capacity storage means, and such limitations remain. Even if it is argued that the limitations regarding storage were broadened, they were not eliminated, and thus application of the recapture rule would be improper. M.P.E.P. § 1412.02 ("However, if the reissue claim recites a broader form of the key limitation added/argued during original prosecution to overcome an art rejection (and therefore not entirely removing that key limitation), then the reissue claim may not be rejected under the recapture doctrine.") (citing *Ex Parte Eggert*, 67 U.S.P.Q.2d 1716 (Bd. Pat. App. & Inter. 2003)) (emphasis added).

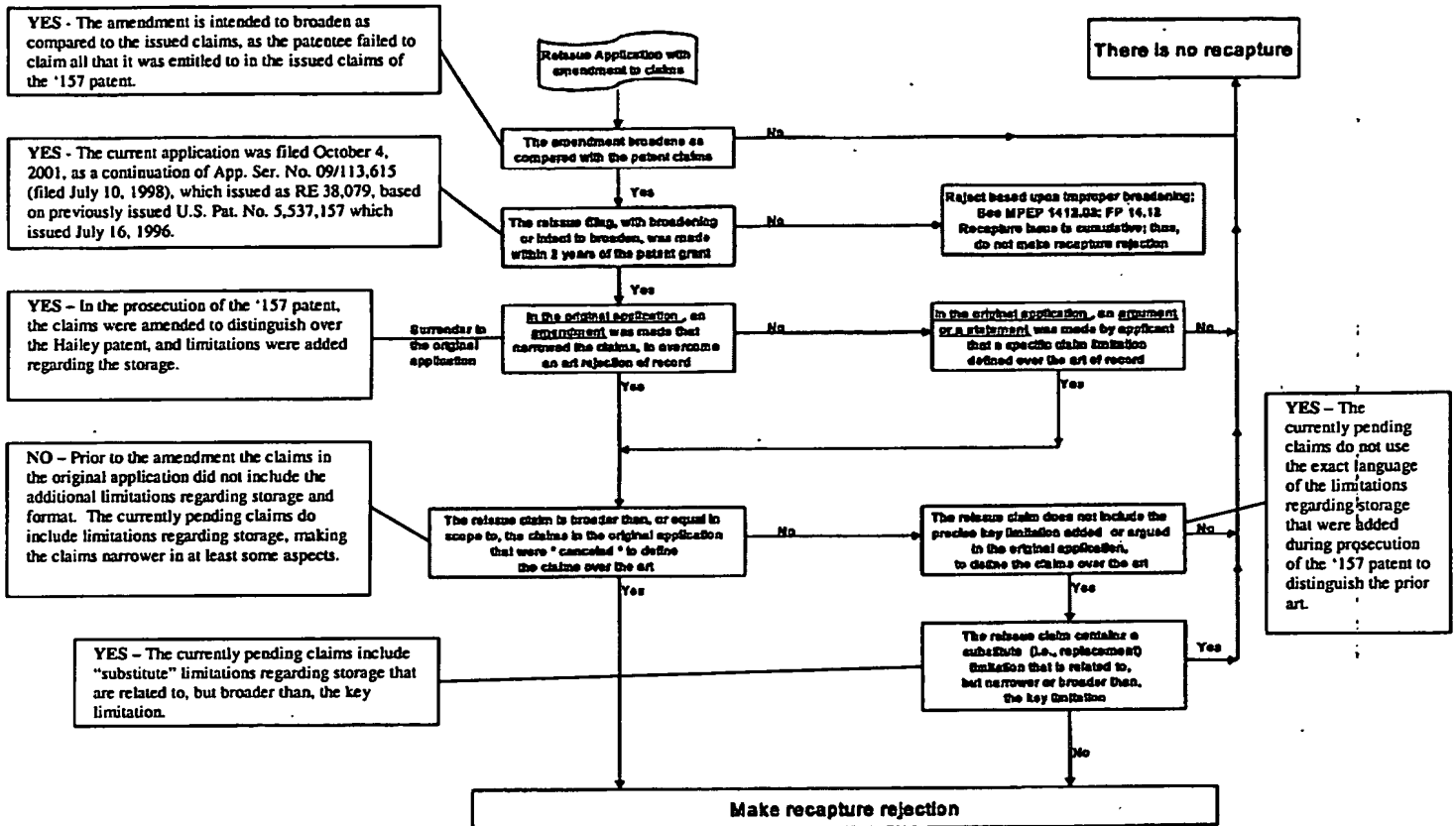
c) **The Current Reissue Claims Are Narrowed in Other Respects**

Because the claims were not impermissibly broadened by completely removing a limitation that was previously surrendered, it is not necessary to reach this question. However, even assuming that this question is reached, the claims were in fact narrowed in certain respects: while the original patent was amended to include a limitation broadly specifying a format that could be stored, the current reissue claims include the specific format of a digital (in one instance, compressed) 24 fps format. The current reissue claims are narrower in that they all either include a limitation that a camera captures the input video or include a limitation of performing non-linear editing on the video program in its production format.

**Appln No. 10/004,046**  
**Response date December 22, 2004**

Section 1400 of the MPEP addresses reissue proceedings, including specific guidelines to apply when addressing a potential recapture situation. As shown below, applying the facts of the present case to the flowchart provided in the M.P.E.P. at 1400-22, there was no recapture of surrendered material in the present case.

**Reissue Recapture - Determining its presence or absence**



**IV. THE PROTESTORS' SECTION 112 ARGUMENTS ARE INAPPLICABLE TO CURRENT REISSUE CLAIMS 256-293 AND LACK MERIT**

Protestors previously raised several arguments alleging insufficient support under 35 U.S.C. § 112. However, such arguments were based on the particular language of the previously pending claims. The majority of Protestors § 112 arguments do not appear applicable to the language of the currently pending claims 256-293. However, Protestors do argue that the

original specification does not support receiving the video information as a 24 fps input signal from the broadcast receiver 210, satellite receiver 212 or data network 214 shown in Fig. 7. Protestors appear to ignore the notation at column 12, lines 26-42 and the drawing of Figure 6, which shows an input program having a frame rate of 24 fps and stating: "FIG. 6 shows the inter-relationship of the various film and video formats compatible with the invention, though not intended to be inclusive of all possible implementations. In typical operations, the multi-format audio-video production system 162 would receive film-based elements 160 and combine them with locally produced materials already in the preferred internal format of 24 frames-per-second." ('079 reissue patent specification at 12:26-32).

In addition, original claims 8-11, which are part of the specification, state that the program in the input format includes 24 fps images. Protestors appear to ignore the notation at column 13, lines 23-26 which notes: "Alternative implementations may employ different frame size (in pixels), aspect ratios, or frame rates, and these variations should be considered to be within the scope of the invention." Original claim 13 further stated that the conversion to a production format at 24 fps occurs only "if necessary," meaning that the input may already be in a 24 fps production format.

Thus, as indicated in Fig. 6, original claims 8-11 and 13, and the discussion of the input to the multi-format production system at column 12, lines 26-42, the input to the system may be 24 fps.

**V. PROTESTORS' PRIOR ART ARGUMENTS ARE INAPPLICABLE AND LACK MERIT**

In addition, Protestors also made several arguments regarding the patentability of the then-pending claims, based on a specific comparison of the claim language to several purported prior art references. Because the language of the claims has changed, these specific arguments are no longer applicable to currently pending claims 256-293. In addition, several of these

Appln No. 10/004,046  
Response date December 22, 2004

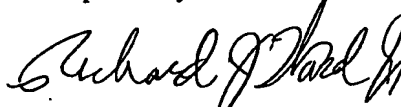
references appear to have previously been considered by the Examiner (and in fact are cited on the face of RE 38,079), and the remainder of the references were submitted by the applicant in the IDS dated August 27, 2004.

**VI. CONCLUSION**

For the reasons stated above, applicant has shown that its claims are properly pending in reissue, and neither 'restriction acquiescence' nor 'recapture estoppel' are applicable in the present case. Applicant respectfully requests that no action be taken based on the protest, and that the Examiner instead resume examination of the currently pending claims 256-293.

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Respectfully submitted,



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